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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,528	08/29/2001	Takayuki Iida	Q64676	4729

7590 11/16/2005

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EXAMINER	
DIVINE, LUCAS	
ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/940,528	IIDA, TAKAYUKI	
	Examiner	Art Unit	
	Lucas Divine	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims 1 – 24 are pending.

2. Title objection withdrawn.

Response to Arguments

3. Applicant's arguments filed 8/31/05 have been fully considered but they are not persuasive.

With respect to applicant's arguments on pages 11-12 that Shih does not teach an image reading section and an image information reading section.

In reply, as previously stated and agreed to by applicant, the reading device 105 of Shih corresponds to an image information reading section. Regarding the image reading section, the scanning of col. 4 lines 36-39 is for scanning the image (col. 4 line 37 'the image 36 can be scanned') and not the image information. Thus, the scanner inherently used in such scanning must be able to scan the image and the claim limitation is met. Further examples as cited from Shih of teaching an image reading section as a scanner are in col. 9 around line 55 and col. 10 around line 8 (col. 10 line 9 states that scanner 'scans the image').

With respect to applicant's arguments on page 12 that Shih does not teach an image reproduction section.

In reply, in order to meet the claim limitation Shih needs to teach one of (as cited in the claim) forming the image from the image data read by the reading section or the image data reading section. In col. 2 lines 5-6 (as cited in the rejection) Shih teaches that the image can be

printed from the image data reading section. Thus, by this teaching alone the claim language is met by the reference because the claim lists being able to print based on one of, no claim language says it must print, or be able to print, both. Further, since the user has the ability to scan the image (col. 4 lines 36-39) on their home scanner (col. 10 lines 8-11) and send it to the remote system (col. 9 lines 5-10) and from there printed as other files through the photofinisher as claimed.

For these reasons, as well as other pertinent teachings of Shih, the rejections are maintained.

Claim Objections

4. Claim 23 is objected to because of the following informalities: server is misspelled twice, once as serer and once as sever. Appropriate correction is required.

5. Claim 20 is objected to as being a substantial duplicate of claim 19. Both claims are the same and they both depend from claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 4, 7, 8, 11, 12, 15, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Shih et al. (US 6674923) hereafter as Shih.

Regarding claim 1, Shih teaches **a printing system** (Fig. 14) **comprising:**

an image server (82, which includes image memory 94; col. 1 lines 64-67, col. 6 lines 48-51) **in which image data of an image formed on an image recording medium** (data stored is of the developed images 35, Fig. 3)**, is stored;**

an image reading section for reading the image formed on the image recording medium (col. 4 lines 36-39, wherein Shih teaches that a user can scan in the image if they would like and print it that way, scanning inherently including a scanner for image reading);

an image information reading section (reading device 105 on kiosk 98 [Fig. 15]; col. 8 lines 44-47, col. 2 lines 4-5) **for reading, from the image recording medium** (barcode 32 on image recording medium 35, Fig. 4)**, image information including information for specifying the image server and a position at which the image data is stored in the image server** (URL 26 is embedded in the machine readable code 32, col. 4 lines 10-20, col. 2 lines 17-21);

an image data reading section (92, which reads the requested data from the image memory 94 and forwards the data to the destination required, for example, photofinishing section 62 for printing; col. 7 lines 24-25) **for reading the image data corresponding to the image information from the image server based on the image information read by the image information reading section** (col. 4 lines 31-34, wherein the images pointed to by the URL can be selected for reprint and the data is read out and sent to the printing section)**; and**

an image reproduction section (photofinishing section 62 includes printers 84, 86, and 88 for reproducing image data for first prints or reprints) **for forming, on another image**

recording medium which is different from the image recording medium (reprints are made, thus the reprint is essentially not on the same print as the first print), **the image formed on the image recording medium based on *one* of image data, read by the image reading section, of the image** (col. 4 lines 36-39, wherein Shih teaches that a user can scan in the image if they would like and print it that way) **or the image data read by the image data reading section** (col. 2 lines 5-6, wherein reprints can be ordered based on the image data in the server).

Regarding claim 2, which depends from claim 1, Shih teaches **the image information reading section is provided so as to read the image information recorded as an invisible image on the image recording medium** (col. 9 line 62 – col. 10 line 6, wherein the data can be stored as hidden [not visible to the user] form in the image itself).

Regarding claims 3 and 4, which depend from claims 1 and 2, Shih teaches **the image information reading section is provided so as to read the image information recorded as a bar code on the image recording medium** (barcode 32 is read by reading section 105, col. 4 line 11 and col. 8 lines 43-44).

Regarding claims 7 and 8, which depend from claims 1 and 2, Shih teaches **the image reading section is used as the image information reading section** (col. 9 line 55, wherein the scanner of a user could be used as the barcode reader).

Regarding claim 11, the structural elements of apparatus claim 1 perform all of the method steps of method claim 11 except for the step listed below. Shih further teaches **reading in image data recorded in an image carried** (scanner 68 reads data from image carriers 64 and 65, memory card reader and CD reader read from image carriers 108 and 106 respectively – col. 9 lines 3-10 teach the prints and digitally stored files can originate from any of the

aforementioned carriers) **and the formed image is based on the data read from the image carrier** (formed image 35 [Fig. 3] is based on the data input to the system via input devices shown in Fig. 14, one of which can be an image carrier such as 106, 108, 64, 65). Thus, method claim 11 is rejected for the same reasons stated above in the rejection of apparatus claim 1 as well as the additional reasons stated.

Regarding claim 12, which depends from claim 11, the structural elements of apparatus claim 2 perform all of the method steps of method claim 12. Thus, method steps of method claim 12 are rejected for the same reasons stated in the rejection of apparatus claim 2.

Regarding claim 15, which depends from claim 11, the structural elements of apparatus claim 3 perform all of the method steps of method claim 15. Thus, method steps of method claim 15 are rejected for the same reasons stated in the rejection of apparatus claim 3.

Regarding claim 24, which depends from claim 1, Shih teaches an **encode section which converts a URL information indicating a position at which the image data is stored** (storage location as a URL is scanned in and the system uses an algorithm to convert the information [col. 10 lines 9-14, col. 8 line 53]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Shih as applied to claims 1 and 2 above, and further in view of Nelson et al. (US 6431448) hereafter as Nelson.

Regarding claims 5 and 6, which depend from claims 1 and 2, while Shih teaches scanning in images for possible printing (col. 4 lines 36-39, wherein Shih teaches that a user can scan in the image if they would like and print it that way), Shih does not specifically teach that the scanner and image information reading device 105 are both in the same device, e.g. kiosk 98.

Nelson teaches a photo kiosk (Fig. 1) for accessing the network and an image storage service and photofinishing service similar to the system of Shih. Nelson further teaches a scanner located at the kiosk (scanner 56).

It would have been obvious to one or ordinary skill in the art to place the scanner spoken of in Shih at the kiosk as taught in Nelson. The motivation for doing so would have been to have all the services needed for the user at one location, thus the intention of a kiosk. The kiosk in the system is designed to take all the functions of a home computer and associated peripherals and place them in a kiosk so that a user who doesn't have a computer can access the same services. Further, Shih and Nelson are both assigned to the same entity, thus implying that the systems work together.

8. Claims 9, 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih as applied to claims 1, 2, and 11 above, and further in view of Bryniarski et al. (US 6215559) hereafter as Bryniarski.

Regarding claims 9 and 10, which depend from claims 1 and 2, while Shih teaches **the image reading section and the image information reading section are provided so as to read the image and the image data formed on the image recording medium, and an image is formed on a by the image reproduction section** (discussed in the rejection of claim 1) and that the photofinishing section develops photos, Shih does not specifically teach that the *photofinishing* section 62 can print on **photographic photosensitive material.**

Bryniarski teaches that photofinishing labs where film is developed, such as the photofinishing section of Shih, can print on **photographic photosensitive material** (col. 4 lines 49-50).

It would have been obvious to one of ordinary skill in the art that the photo processing system of Shih prints photographs such as 35 on photosensitive material. The motivation for doing so would have been to print high quality prints without using ink and photosensitive material prints are generally sturdier than standard paper. Further, Shih and Bryniarski are both assigned to the same entity, thus implying that the systems work together.

Regarding claim 13, which depends from claim 11, while Shih teaches that the **image carrier is a photographic film** (film 64, Fig. 14) Shih does not specifically teach that the *photofinishing* section 62 can print on **photographic photosensitive material.**

Bryniarski teaches that photofinishing labs where film is developed, such as the photofinishing section of Shih, can print on **photographic photosensitive material** (col. 4 lines 49-50).

It would have been obvious to one of ordinary skill in the art that the photo processing system of Shih prints photographs such as 35 on photosensitive material. The motivation for

doing so would have been to print high quality prints without using ink and photosensitive material prints are generally sturdier than standard paper. Further, Shih and Bryniarski are both assigned to the same entity, thus implying that the systems work together.

Regarding claim 14, which depends from claim 11, while Shih teaches **the image carrier is a media for recording image data of an image photographed by a digital still camera** (media 108, Fig. 14), Shih does not specifically teach that the *photofinishing* section 62 can print on **photographic photosensitive material.**

Bryniarski teaches that photofinishing labs where film is developed, such as the photofinishing section of Shih, can print on **photographic photosensitive material** (col. 4 lines 49-50).

It would have been obvious to one of ordinary skill in the art that the photo processing system of Shih prints photographs such as 35 on photosensitive material. The motivation for doing so would have been to print high quality prints without using ink and photosensitive material prints are generally sturdier than standard paper. Further, Shih and Bryniarski are both assigned to the same entity, thus implying that the systems work together.

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shih as applied to claim 1 above, and further in view of well known prior art.

Regarding claim 22, which depends from claim 1, while Shih teaches using a scanner in the system for scanning the image (e.g. col. 4 lines 36-39, col. 9 line 55, col. 10 line 8) and being able to store such an image at the server (col. 9 line 9, wherein the file from the remote computer

[scanner can be at remote computer for scanning images as discussed in col. 10] can be sent to the server for storage), Shih does not specifically teach the scanner to read two dimensionally.

However, Examiner takes Official Notice that well known prior art teaches scanners that scan both in the X direction (first dimension) and Y direction (second dimension) because images are almost always two dimensional.

It would have been obvious to one of ordinary skill in the art that the scanner of Shih could have scanned two dimensionally. The motivation for doing so would have been to be able to scan two dimensional images, which is almost all images.

10. Claims 16 – 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih as applied to claims 1, 2, and 11 above, and further in view of Kodaira et al. (US 6868183).

Regarding claims 19 – 21, which depend from claims 1 and 11, Shih specifically teaches while a user can scan in a copy of the picture for reprinting, it is more desirable to have accessed to the original stored data file for better printout quality (col. 4 lines 36 – 49). Thus it is known that the user data can be based on the scanned data or the data on the image server and it is taught by Shih that it would be more desirable to print the original image data on the server if it is available.

Since the lines specifically suggest that a user would not want to print a scanned copy over the original copy data, the cited lines of Shih do not specifically teach that the decision to print the more desirable type is made by a computing unit.

However, Kodaira teaches the well known features of having a computing unit automatically print the image that is more desirable / produces the best results (Fig. 7 is an

example of automatically printing the most desirable – ST207 is an automatic step operated by a computing system for printing the best result, thus it is clearly taught to have a computing system automatically print the most desirable result).

It would have been obvious to one of ordinary skill in the art to have the system of Shih automatically print the type of image output that would produce the best result, and thus print the original stored digital file if it is available. The motivations for making this process automated would be to always produce the best result, without having to worry about user mistakes. And as Shih states, it would clearly make sense to one of ordinary skill in the art to have the best original data to be used in printing. In a case where there was no original data on the server, the user would have no other option but to used the scanned non-original data for the printing.

Regarding claims 16 – 18, which depend from claims 1, 2, and 11, the combination of claims 19-21 automatically includes an image processing section that would make a decision based on the image type for the best results (further see Fig. 7 of Kodaira - steps ST204-ST206, and image processing section inherently performing the image processing steps, further figures show more details of the system).

Regarding claim 23, which depends from claim 1, arguments analogous to claims 19 – 21 are applicable to claim 23. In both cases, the best result would be desired, and so if there is the original image data at the server, use it, if not, use what you do have in order to produce the best result possible with what the system currently has.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Redd et al. (US 2005/0190400) teaches image printing for multiple recipients.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2624

ljd

KING Y. POON
PRIMARY EXAMINER